

3. Claims 1, 2, 4, 5, 7-13, 17 drawn to a method of treating a subject afflicted with a condition that includes G3, but excludes G1 and G2, said method comprising administering any peptide, including G5, provided that G6 is excluded.

4. Claims 1, drawn to a method of treating a subject afflicted with a condition that includes G1, but excludes G2 and G3, said method comprising administering any peptide, including G6, provided that G5 is excluded.

5. Claims 1, drawn to a method of treating a subject afflicted with a condition that includes G2, but excludes G1 and G3, said method comprising administering any peptide, including G6, provided that G5 is excluded.

6. Claims 1, drawn to a method of treating a subject afflicted with a condition that includes G3, but excludes G1 and G2, said method comprising administering any peptide, including G6, provided that G5 is excluded.

7. Claims 14-15, drawn to a method of treating a subject with a binary mixture of active agents.

G1 through G6 are subgenera identified by the Examiner. The Examiner also required election of a peptide species and a specific disorder species.

#### REMARKS

Claims 18-42 are pending in this application and presented for examination, as claims 1-17 have been canceled by the Preliminary Amendment filed concurrently herewith. In response to the restriction requirement, Applicants elect, with traverse, Group 1, drawn to a method of treating a subject afflicted with a condition that includes G1, but excludes G2 and G3, said method comprising administering any peptide, including G5, provided that G6 is excluded. Claims readable thereon include claims 18-35, 38 and 39. Applicants elect, with traverse, G5 as the peptide species. Applicants elect, with traverse, G1 as the specific disorder that is the target of the treatment. Reconsideration is respectfully requested.

**A. It is improper to restrict a single claim into multiple groups.**

Applicants respectfully traverse this restriction requirement. This restriction requirement has improperly restricted several claims into multiple groups. For example, claim 1 has been placed into 6 restriction groups, claim 2 has been restricted into 3 groups, and claims 7-13 have been restricted into 3 groups. Each of these groups contain generic claims

that are directed to methods of treating a subject having a pathological condition involving neovascularization with a R'-Glu-Trp-R" compound. Groups 1-6 differ in the pathological condition and the peptide species as classified by the Examiner. In essence, the Examiner has restricted claims 1, 2, 7-13 into multiple groups as though they were species recited in different claims. This is improper as "[c]laims are definitions of inventions" and are "*never species.*" MPEP § 806.04(e) (emphasis in original).

Because the restriction requirement splits a single claim into multiple groups, the restriction requirement is improper as a matter of law. If the instant restriction requirement is not withdrawn, Applicants will never be accorded "the basic right of the applicant to claim his invention as he chooses." *See, In re Weber*, 198 USPQ 328, 331 (CCPA 1978). In *In re Weber*, the CCPA stated that "[a]s a general proposition, an applicant has a right to have *each* claim examined on the merits" (198 USPQ at 331, emphasis in original). The Court went on to state that:

[i]f . . . a single claim is required to be divided up and presented in different applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. 198 USPQ at 331.

Even if Applicants file a divisional application to obtain coverage of the use of different types of peptide species and conditions to achieve the claimed methods, they would not have the opportunity to have examined their broader claims, which recite methods of inhibiting neovascularization in a subject in need thereof with the claimed R'-Glu-Trp-R" compounds. That the Examiner may have to examine references that disclose a particular compound as also involving neovascularization is *not* a basis for splitting a single claim into multiple groups. Applicants therefore request that the restriction requirement be withdrawn.

**B. The restriction requirement is also improper under M.P.E.P. § 803.**

Election between Groups 1 through 7

Under M.P.E.P. § 803, restriction is proper only when two criteria are met: (A) The inventions must be independent (MPEP §§ 806.04-806.04(i)) or distinct (MPEP §§ 806.05-806.05(i)); **and** (B) there must be a serious burden on the Examiner if restriction is required.

Applicant contends that no undue burden is posed to the Examiner to search for references relevant to Groups 1 through 7. In searching for references relevant to the R'-Glu-Trp-R" compounds as claimed in the Preliminary Amendment, references relevant to methods of inhibiting neovascularization in a subject in need thereof with the claimed R'-Glu-Trp-R" compounds will likely be found. In addition, searches have already been conducted for L-Glu-L-Trp in two parent cases: U.S. Patent 5,902,790 (Issuing on May 11, 1999 from Appl. No.: 08/614,764) and U.S. Patent 6,096,713 (Issuing August 1, 2000 from Appl. No.: 09/260,190). The present Appl. No. 09/506,430 is a continuation application of Appl. No.: 09/260,190, which is a continuation application of Appl. No.: 08/614,764. Furthermore, there were no restriction requirements made in Appl. No.: 09/260,190 or Appl. No.: 08/614,764. Therefore, no undue burden is posed to the Examiner to search for references relevant to all of the claims as they appear in the Preliminary Amendment. Accordingly, Applicant requests that this restriction requirement be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants request that the Restriction Requirement be withdrawn and early examination of all the claims on the merits conducted forthwith. Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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